REMARKS

With entry of this amendment, claims 23-29, 33-44, 48, 49, and 70-75 are pending in this application. Of these, claims 23-44, 47-49 stand rejected, and claims 70 and 71 have been newly added. Claims 30-32 and 45-47 have been cancelled by this amendment. Based on the foregoing amendments and the following remarks, reconsideration of this application and allowance of the claims is respectfully requested.

Specification-Objections

The specification is objected to for incorporating a United States patent application by reference without indicating the serial number of the application. Accordingly, the specification has been amended by inserting the serial number into the patent application referred to on page 12, line 19 of the specification. As such, Applicant respectfully requests withdrawal of this specification objection.

Claim Rejections-35 U.S.C. §112

Claims 41 and 42 stand rejected under 35 U.S.C. §112, second paragraph, for failing to provide antecedent basis for the language "the one or more bosses." Accordingly, these claims have been amended to instead refer to "the one or more bosses or recesses," which language has antecedent basis in claim 40. As such, Applicant respectfully requests withdrawal of the §112 rejections of claims 41 and 42.

Claim Rejections-35 U.S.C. §102

Claims 35-39, 44, 48, and 49 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,530,922 issued to Cosman et al. ("Cosman"). Applicant respectfully traverses this rejection, since Cosman does not disclose each and every element of these claims.

In particular, independent claim 35 has been amended to clarify that the sets of the ablation probes are sequentially operated to create the plurality of lesions. Support for this amendment can be found in the specification, at page 23, lines 9-20. In contrast, the probes illustrated and described in Cosman are simultaneously operated, so that the probes act as a single larger electrode. (See col. 8, lines 33-52; col. 9, lines 31-56; col. 11, lines 8-27). Thus, Applicant submits that independent claim 35, as well as the claims depending therefrom (claims 36-39, 44, 48, and 49), are not anticipated by Cosman, and as such, respectfully requests withdrawal of the §102 rejections of these claims.

Claim Rejections-35 U.S.C. §103

Claims 23-29, 33, and 34

Claims 23-29, 33, and 34 stand rejected under 35 U.S.C. §103 as being obvious over U.S. Patent Application Publication No. US 2002/0052610 to Skakoon et al., in view of Cosman. Applicant respectfully traverses this rejection, since neither Skakoon nor Cosman, alone or in combination, disclose, teach, or suggest the elements required by these claims.

As an initial matter, it is not clear whether the Examiner, in forming a basis for this obviousness rejection, has modified the teachings of Skakoon with that of Cosman, or vice versa. That is, although the Examiner initially sets forth Skakoon as the primary reference, and Cosman as the secondary reference in the introductory statement, in the body of the rejection, the Examiner

supplemented the Cosman method with a step disclosed in Skakoon, which appears to indicate that Cosman is actually used as a primary reference, with Skakoon being the secondary reference. Because Cosman is directed to a tumor ablation method, whereas Skakoon is directed to a method of delivering medical instruments into an organ, Applicant will assume that the Examiner intended for Cosman to be the primary reference. If Applicant is in error, however, the Examiner is requested to clarify the ordered significance of the references.

In any event, Applicant believes that Cosman and Skakoon cannot be properly combined to provide the basis for a prima facie obviousness case. In particular, Skakoon is not analogous prior art that can be relied on by the Examiner. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." (M.P.E.P. §2141.01(a)). In this case, the field of Applicant's endeavor is the field of therapeutic tissue ablation, whereas the field of endeavor that the Skakoon device is the field of deep brain stimulation. The problem addressed by Applicant is the need to provide accurate compound lesions within tumors, whereas the problem addressed by Skakoon is the accurate delivery of a deep brain stimulation lead adjacent a target region within the brain. It is noted that although the Examiner characterized the Skakoon medical probe as an ablation probe, it is not disclosed as being an ablation probe, but rather a deep brain stimulation electrode. (See paragraph [0048]).

Even if Skakoon is analogous prior art that can be relied on by the Examiner, there is no suggestion in Skakoon to modify the ablation system of Cosman in the manner described by the Examiner. In particular, Skakoon discloses that if the brain stimulation probe 100 misses the target location 108 after guiding it though a center opening 1124A of the device, the stimulation probe 100

can be reinserted into one of the side openings 1124B-E. (See paragraph [0065]). Thus, the most that Skakoon suggests with regard to the Cosman ablation system is that one of the probes 1-3 can be reinserted into another guide hole within guide element 14 if it misses the targeted ablation region T, in which case, the probe will not be operated to ablate the tissue region T after being misguided through the previous guide hole, but rather, will be operated only once after the probe has been accurately positioned adjacent the tissue ablation region T. That is, the multiple apertures of the guide element 14 are to be used to provide alternative means of accurately placing the probe into the targeted ablation region T. In contrast, the claimed invention contemplates that the probe will be operated multiple times to create a compound lesion. That is, claim 23 requires guiding the ablation probe within a first aperture of the alignment device, operating the ablation probe to create a first lesion within a first targeted tissue region, guiding the ablation probe with a second aperture of the alignment device adjacent a second targeted tissue region, and the operating the ablation probe again to create a second lesion within a second targeted tissue region. Skakoon does not suggest that the Cosman ablation system be modified to perform these steps.

Thus, Applicant submits that independent claim 23, as well as the claims depending therefrom (claims 24-34), are not obvious in view of the combination of Cosman and Skakoon, and as such, respectfully requests withdrawal of the §103 rejection of claims 23-34.

Claims 40 and 43

Claims 40 and 43 stand rejected under 35 U.S.C. §103 as being obvious over Cosman in view of Skakoon. Applicant respectfully traverses this rejection, since neither Cosman nor Skakoon, alone or in combination, disclose, teach, or suggest the elements required by these claims. In particular, as previously discussed, Cosman does not disclose sequential operation of sets of ablation

probes to create the plurality of lesions, as required by independent claim 35 from which claims 40 and 43 depend, and Skakoon does not supplement this failed teaching.

Thus, Applicant submits that claims 40 and 43 are not obvious in view of the combination of Cosman and Skakoon, and as such, respectfully requests withdrawal of the §103 rejection of these claims.

New Claims

Applicant submits that claims 70 and 71, which have been newly added, find support in the specification, as originally filed, and are patentable over the cited prior art.

Conclusion

Based on the foregoing, all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (714) 830-0600.

Respectfully submitted,

BINGHAM MCCUTCHEN LLP

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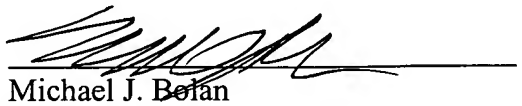
By: 
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